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TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
ITL.0658US

In Re Application Of: **Jeremy Burr**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/930,779	**August 15, 2001**	**Tuan A. Tran**	**21906**	**2682**	**2581**

Invention: **Establishing Communications Between Devices Within a Mobile Ad Hoc Network**

COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on **January 11, 2006**

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Dated: **February 27, 2006**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant: Jeremy Burr	§	Art Unit:	2682
Serial No.: 09/930,779	§	Examiner:	Tuan A. Tran
Filed: August 15, 2001	§	Atty Docket:	ITL.0658US (P11212)
For: Establishing Communications Between Devices Within a Mobile Ad Hoc Network	§	Assignee:	Intel Corporation

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APPEAL BRIEF

Date of Deposit: February 27, 2006
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Nancy Meshkoff

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REAL PARTY IN INTEREST

The real party in interest is the assignee Intel Corporation.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-30 (Rejected).

Claims 1-30 are rejected and are the subject of this Appeal Brief.

STATUS OF AMENDMENTS

All amendments have been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

In the following discussion, the independent claims are read on one of many possible embodiments without limiting the claims:

1. A method comprising:

obtaining, on a first wireless device (X), a contact list of second wireless devices (Y,...) with which the first wireless device has communicated in the past, including a first contact (Y) in-range from the first wireless device (X) and a second contact (Z) being out-of-range from the first wireless device (X) (Figure 1; Specification at page 4, line 5 through page 5, line 9);

automatically establishing a communication route between the first wireless device (X) and the first contact (Y) (Specification at page 5, lines 10-17); and

automatically establishing a communication route from the first wireless device (X) to a second contact (Z) through the first contact (Y) (Specification at page 9, lines 1-9).

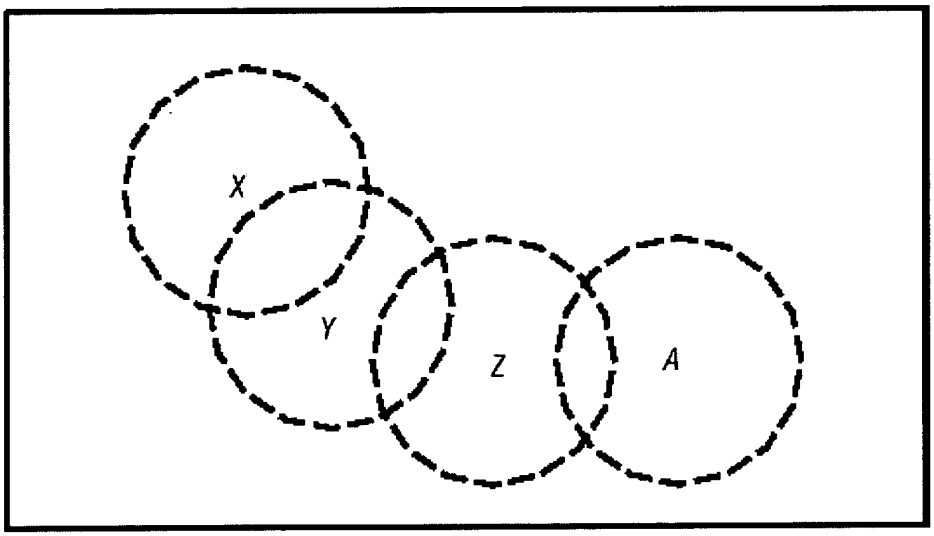

FIG. 1

At this point, no issue has been raised that would suggest that the words in the claims have any meaning other than their ordinary meanings. Nothing in this section should be taken as an indication that any claim term has a meaning other than its ordinary meaning.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Are claims 1-30 anticipated by Haartsen?

ARGUMENT

A. Are claims 1-30 anticipated by Haartsen?

The rejection should be reversed because the only possible basis for the rejection is one of inherency. However, in order to make out a rejection that is based on the element being inherent, is not sufficient if a certain result or characteristic may occur or be present in the prior art. See M.P.E.P. § 2112, page 2100-57, "The Examiner must provide rationale or evidence tending to show inherency." Instead, the result must necessarily adhere.

Here, the claim requires that a contact list for a first wireless device be obtained. That contact list should include in-range device and out-of-range devices and both the in-range and out-of-range devices must be devices which the first wireless device has communicated with in the past.

While there are in-range and out-of-range devices in the list prepared in the reference, the out-of-range devices are not devices with which the first wireless device has communicated with in the past. The reason for this position is that the reference merely states that the list is compiled of in-range devices and devices that the in-range devices have communicated with. Therefore, the first wireless device need not have communicated with any of those out-of-range devices.

Thus, the issue comes down to whether or not the reference teaches that, necessarily, the list includes devices which the first wireless device has communicated with in the past and which are out-of-range. Mere accidental or unintentional acts are not sufficient. It is necessary that the reference teach something which necessarily occurs. See M.P.E.P. § 2112.

Here, all we know is that out-of-range devices are put on the list only because they have communicated with in-range devices (other than the first wireless device). However, that list need not include out-of-range devices with which the first wireless device has communicated with in the past. That is because the only requirement in the reference is that in-range devices have the out-of-range devices listed in their lists. There is no reason to presume that those out-of-range devices would necessarily have been the subject of communications with the first wireless device whose list is being compiled.

Federal Circuit decisions emphasize that an anticipatory inherent feature or result must be consistent, necessary, and inevitable, not merely possible or probable. See *Transclean Corp. v. Bridgewood Services, Inc.,* 290 F.3d 1364, 1373, 62 U.S.P.Q.2d 1865 (Fed. Cir. 2002) ("anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation ... ."); *Mehl/Biophile International Corp. v. Milgraum,* 192 F.3d 1362, 1365, 52 U.S.P.Q.2d 1303 (Fed. Cir. 1999) ("Occasional results are not inherent."); *In re Robertson,* 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (the PTO Board erred in holding that a prior art reference anticipated by inherency an applicant's claim, which concerned a diaper fastening and disposal system; the Board's analysis rested on mere probability or possibility, i.e., that elements in the reference could be used other than as disclosed and for a different function ("odd use"); such probability or possibility is not sufficient to establish inherency); *W.L. Gore & Associates, Inc. v. Garlock, Inc.,* 721 F.2d 1540, 1554, 220 U.S.P.Q. 303 (Fed. Cir. 1983) ("Anticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in the references.").

The Examiner is suggesting that, sometime in the practice of the invention disclosed in the reference, it might be possible that an in-range device would have an out-of-range device on its list that the first wireless device has communicated with in the past. However, this is insufficient as expressly found, for example, in the *Robertson* case and the *Gore v. Garlock* cases, to make out an inherency rejection.

Since none of the prior art teaches populating the list on a first wireless device with both in-range and out-of-range devices with which the first wireless device has communicated in the past, the rejection should be reversed.

Applicant respectfully requests that each of the final rejections be reversed and that the claims subject to this Appeal be allowed to issue.

Respectfully submitted,

Date: 2/27/06

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CLAIMS APPENDIX

The claims on appeal are:

1. A method comprising:

obtaining, on a first wireless device, a contact list of second wireless devices with which the first wireless device has communicated in the past, including a first contact in-range from the first wireless device and a second contact being out-of-range from the first wireless device;

automatically establishing a communication route between the first wireless device and the first contact; and

automatically establishing a communication route from the first wireless device to a second contact through the first contact.

2. The method of claim 1 wherein obtaining the contact list includes acquiring information from a list of addressees on the first wireless device.

3. The method of claim 1 including automatically exchanging lists of contacts with in-range second wireless devices, comparing the lists of contacts, and identifying common contacts in said lists.

4. The method of claim 3 including exchanging lists of common contacts between two devices with other in-range devices.

5. The method of claim 1 including storing information sufficient to establish a communication route from said device to said second contact.

6. The method of claim 1 including storing information related to said first contact.

7. The method of claim 6 including storing information about whether said second contact is active.

8. The method of claim 7 including sharing information with other in-range devices about whether said first contact is active.

9. The method of claim 1 including periodically updating information about in-range devices.

10. The method of claim 1 including storing an alternative communication route to said second contact.

11. An article comprising a computer readable medium storing instructions that, if executed, enable a processor-based first wireless device to:

obtain a contact list of wireless devices which the first wireless device has communicated in the past, including a first contact in-range from the first wireless device and a second contact being out-of-range from the first wireless device;

automatically establish a communication route from the first wireless device to a first contact; and

automatically establish a communication route from the first wireless device to a second contact through the first contact.

12. The article of claim 11 further storing instructions that enable the first wireless device to acquire information from a list of addressees on a device.

13. The article of claim 11 further storing instructions that enable the first wireless device to automatically exchange lists of contacts with in-range devices, compare the lists of contacts, and identify common contacts in said lists.

14. The article of claim 13 further storing instructions that enable the first wireless device to exchange lists of common contacts between two devices with other in-range devices.

15. The article of claim 11 further storing instructions that enable the first wireless device to store information sufficient to establish a communication route from said device to said second contact.

16. The article of claim 11 further storing instructions that enable the first wireless device to store information related to said first contact.

17. The article of claim 11 further storing instructions that enable the first wireless device to store information about whether said second contact is active.

18. The article of claim 17 further storing instructions that enable the first wireless device to share information with other in-range devices about whether said first contact is active.

19. The article of claim 11 further storing instructions that enable the first wireless device to periodically update information about in-range devices.

20. The article of claim 11 further storing instructions that enable the first wireless device to store an alternative communication route to said second contact.

21. A system comprising:

a processor;

a storage coupled to said processor storing instructions that enable the processor to:

obtain a contact list of contacts that the system has communicated with before, including a first contact in-range from the device and a second contact being out-of-range from the device;

automatically establish a communication route from the device to a first contact; and

automatically establish a communication route from the device to a second contact through the first contact.

22. The system of claim 21 wherein said storage stores instructions that enable the processor to acquire information from a list of addressees on a device.

23. The system of claim 21 wherein said storage stores instructions that enable the processor to automatically exchange of lists of contacts with in-range devices, compare the lists of contacts, and identify common contacts in said lists.

24. The system of claim 23 wherein said storage stores instructions that enable the processor to exchange lists of common contacts between two devices with other in-range devices.

25. The system of claim 21 wherein said storage stores instructions that enable the processor to store information sufficient to establish a communication route from said device to said second contact.

26. The system of claim 21 wherein said storage stores instructions that enable the processor to store information related to said first contact.

27. The system of claim 21 wherein said storage stores instructions that enable the processor to store information about whether said second contact is active.

28. The system of claim 27 wherein said storage stores instructions that enable the processor to share information with other in-range devices about whether said first contact is active.

29. The system of claim 21 wherein said storage stores instructions that enable the processor to periodically update information about in-range devices.

30. The system of claim 21 wherein said storage stores instructions that enable the processor to store an alternative communication route to said second contact.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.